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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/629,063

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Alexey S. Kabalnov

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EXAMINER

HUFFMAN, JULIAN D

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/629,063	Applicant(s) KABALNOV ET AL.	
	Examiner Julian D. Huffman	Art Unit 2853	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7, 8, 10-24 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 5, 10, 11, 13, 17, 19, 21, 22 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7, 8, 12, 14-16, 18, 20, 23 and 26-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 2, 3, 5, 10, 11, 13, 17, 19, 21, 22 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2 May 2005.

### *Claim Rejections - 35 USC § 102*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 27, 28, 30 and 31 are rejected under 35 U.S.C. 102(e) and 35 U.S.C. 102(a) as being anticipated by Lee.

Lee discloses:

With regards to claims 27 and 28, a print medium (fig. 2) having a magnetic strip (8) as a data storage device attached thereto, said print medium being configured to receive a printed image, and said data storage device being configured to receive and store printing information comprising data related to content of the printed image (0021, "magnetic layer containing a magnetically encoded copy of the text and images printed on the ink receptive layer 10").

With regards to claims 30 and 31, a method of associating printing information with a print medium, comprising the steps of:

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attaching a magnetic strip (8) as a data storage device to a print medium;  
and  
storing printing information on the data storage device, said printing information comprising data related to content of a printed image applied to the print medium (0021).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23, 26, 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Smith.

Lee discloses:

With regards to claims 1, 4 and 7, a print medium (fig. 2) having a data storage device (fig. 2, element 8) attached thereto (section 0019, the reference refers to element 2 which represents the entire structure shown in fig. 2 including the ink receptive layer 10, magnetic layer 8 and base layer 6 which are attached using adhesive or the like), said print medium being configured to receive a printed image (layer 10 receives a printed image 14), and said data storage device configured to receive and store printing information (0021, magnetically

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encoded copy of the printed text and images), wherein the data storage device comprises a magnetic strip (8) and stores data related to the printed image.

With regards to claims 8 and 16, an ink jet printing system (0011, 0017) comprising:

- a print medium configured to receive a printed image (fig. 2, layer 10 receives printed image 14);

- a data storage device (8) attached to the print medium (0019, the reference refers to element 2 which represents the entire structure shown in fig. 2 including the ink receptive layer 10, magnetic layer 8 and base layer 6 which are attached using adhesive or the like), said data storage device configured to receive and store printing information (0021);

- a printer configured to print the image on the print medium (0011, 0017) and

- a printing information processor associated with the printer, said printing information processor comprising a data read processor capable of reading data from the data storage device (a processor would be required to read the magnetic data).

With regards to claims 12 and 15, the data storage device comprises a magnetic strip (8) which stores information relating to the printed image (0021).

With regards to claims 20, 23 and 26, a method of associating printing information with a print medium, comprising the steps of:

- attaching a data storage device comprising a magnetic strip (8) to a print medium (0019, the reference refers to element 2 which represents the entire

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structure shown in fig. 2 including the ink receptive layer 10, magnetic layer 8 and base layer 6 which are attached using adhesive or the like); and

storing printing information, including information relating to printed material applied to the print medium, on the data storage device (0021).

Lee discloses everything claimed with the exception of the printing information processor integrated with the printer capable of reading *and* writing data and providing information indicative of properties of a print medium.

Smith discloses a printing information processor (fig. 1, element 20) integrated with a printer (10) which controls the printer to print and read a code on the print media (fig. 2, controller is connected to optical sensor 34 which reads the data and printhead 12 which prints the data on the paper, column 3, lines 47-50, column 4, lines 19-22), wherein the code includes data which indicates the type of print medium used in the printer (column 3, lines 35-38).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide Lee with an information processor to read and write the information and to store the media type in the code, as taught by Smith into Lee, for the purpose of providing a means for the printer to read and write the coded information thereby enabling functionality of the system without requiring external control or processing means and providing information about media type to the printer controller to automatically optimize print quality for the designated media type (column 2, lines 20-23).

***Response to Arguments***

6. Applicant's arguments filed 18 August 2005 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1, 4, 7, 8, 12, 15, 16, 20, 23 and 26 have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendment.

Applicant's statement that the examiner has failed to establish a prima facie case of obviousness by failing to provide motivation for the combination of Lee and Smith in the rejection of claims 6, 9, 14, 18 and 25 is clearly incorrect since it was stated in the rejection that:

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide Lee with an information processor to read and write the information and to store the media type in the code, as taught by Smith into Lee, for the purpose of providing a means for the printer to read and write the coded information thereby enabling functionality of the system without requiring external control or processing means and providing information about media type to the printer controller to automatically optimize print quality for the designated media type (column 2, lines 20-23).

Applicant presents statements regarding Lee and Smith individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

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F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's allegation that the 103 rejection is the result of hindsight reasoning is noted. However, since the examiner has provided proper motivation for the combination, the issue of hindsight reasoning is moot, *See Dembiczak*, 175 F.3d at 999, 50 USPQ 2d at 1617 ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references"). Furthermore, the rejection makes clear how the "skilled artisan, with no knowledge of the claimed invention, would have selected the components for combination in the manner claimed", *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). It is also noted that the motivation for the combination provided by Smith is relevant and realized irrespective of the type of memory device used and that both references involve the use of memory devices to store information on print media in an inkjet printer.

Applicant's statement that combining Smith and Lee provides a print media with both a magnetic layer and a bar code is misrepresentative of the specific language in the rejection. Applicant is respectfully referred to the obvious statement in the office action, reproduced above, and applicant's summary of the office action found on page 7, last paragraph of the remarks, which states that, "It was held... that it would have been obvious to one having ordinary skill in the art



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*to modify Lee to store information related to the media type in the Lee data storage device."*

Applicant's argument regarding claim 8, that neither Lee or Smith discloses a printing system with a read/write processor capable of both reading data from and writing data to a data storage device is noted. However, in formulating this argument, applicant entirely disregarded the supporting passages provided in the rejection. Smith discloses a controller 20 which reads and writes data to a data storage device, as described on column 3, lines 47-50 and column 4, lines 19-22.

Applicant's argument regarding claims 27 and 30, that the prior art does not disclose storing data related to the content of the printed image, is noted. However, Lee clearly discloses this in section 0021 wherein it is stated that the magnetic layer contains a magnetically encoded copy of the text and images printed on the ink receptive layer.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (571) 272-2147. The examiner can normally be reached on 9:30a.m.-6:00p.m. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Julian D. Huffman  
29 August 2005

  
K. FEGGONS  
PRIMARY EXAMINER